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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,022	11/27/2001	Steven O. Markel	043978-039000	6138

22204 7590 01/23/2008  
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EXAMINER
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VU, NGOC K

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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01/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/997,022	<b>Applicant(s)</b> MARKEL, STEVEN O.	
	<b>Examiner</b> Ngoc K. Vu	<b>Art Unit</b> 2623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-7,9-14,16,17,19 and 22-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9-14,16,17,19 and 22-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's arguments filed 11/2/2007 have been fully considered but they are not persuasive.

With respect to claim 1, applicant argues that Zigmond does not teach adjusting said display window to a predetermined size in response to said ad event signal as claimed. This argument is not persuasive.

As interpreted in the previous Office Action, Zigmond teaches that the ad insertion device 80 interrupts display of the video programming content to insert in its place a selected advertisement based upon the presence of a triggering signal. See column 15, lines 57-61; col. 17, lines 25-31. In this view, the ad insertion device 80 arranges or makes suitable for displaying the advertisement on a display screen in full screen in response to the trigger signal. In other words, Zigmond's ad insertion device "adjusts" the display screen to a predetermined size in response to the trigger signal in terms of presenting the advertisement on the display screen in a full screen size.

Applicant further argues "there is no teaching in Zigmond of disabling control function, e.g., size, of the display window, as claimed in claim 1." Examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., disabling control function of the display window with respect to the size of the display window) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to claim 12, applicant argues that Siler does not teach "overlaying the streaming video program **with an ad in the same video presentation program**" as claimed in

claim 12. (Emphasis added). Examiner respectfully disagrees. It is noted that the above features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 4-7, 9-11, 17, 19, 22, and 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond (US 6,698,020).

Regards to claim 1, Zigmond discloses a method for displaying advertising in conjunction with a streaming video program comprising: presenting a streaming video program in a video presentation window (displaying a video program on a screen 58) (see Fig. 7 and 58; Fig. 8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37), pausing presentation of the streaming video program in response to the ad event signal (the advertisement insertion device interrupts the display of the video programming in response to the trigger signal - column 15, lines 57-61; col. 17, lines 25-31); opening a display window and adjusting said display window to a predetermined size in response to said ad event signal (the ad insertion device 80 interrupts display of the video programming content to insert in its place a selected advertisement based upon the presence of a triggering signal. It must be understood that the ad

insertion device 80 arranges or makes suitable for displaying the advertisement on a display screen in full screen size response to the trigger signal. See column 15, lines 57-61; col. 17, lines 25-31); disabling at least one control function of said display window (since the advertisement is displayed on the display screen in full screen size, displaying the video program on the display screen is disabled); displaying advertisement in the display window (displaying the advertisement on the display screen); closing the display window in response to the display window in response to advertisement completing and resuming presentation of the streaming video program (after the advertisement is complete, resuming display of the video program on the display screen - see col. 17, lines 35-37).

Regarding claim 4, Zigmond inherently teaches adjusting the display window to full-screen size (See column 15, lines 57-61; col. 17, lines 25-31).

Regarding claim 5, Zigmond discloses the ad even signal that is embedded in the streaming video program (column 8, lines 39-41; col. 15, lines 47-52).

Regarding claim 6, Zigmond discloses the ad event signal that is generated by a software program operating at the receiver (the system includes computer-readable media having computer executable instructions and software is included in the ad insertion device - see column 6 lines 48-50 line 26-36; col. 15, lines 40-44).

Regarding claim 7, Zigmond discloses a method for displaying advertising in conjunction with a streaming video program comprising: presenting a streaming video program in a video presentation window (displaying a video program on a screen 58) (see Fig. 7 and 58; Fig. 8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37), pausing presentation of the streaming video program in response to the ad event signal (the advertisement insertion device interrupts the display of the video programming in response to the trigger signal - column

15, lines 57-61; col. 17, lines 25-31); disabling at least one control function of said video presentation window in response to said ad event signal (since the advertisement is displayed on the display screen in full screen size in response to the trigger signal, displaying the video program on the display screen is disabled); adjusting said video presentation window to a predetermined size in response to said ad event signal (the advertisement is displayed on a display screen in a full screen size in response to the trigger signal. See column 15, lines 57-61; col. 17, lines 25-31); displaying advertising in said video presentation window in response to said ad event signal (column 15, lines 57-61; col. 17, lines 25-31); re-enabling said at least one control function of said presentation window (re-enabling the control function of displaying the video program on the display screen after the advertisement is complete) and resuming presentation of the streaming video program (col. 17, lines 35-37).

Regarding claim 9, Zigmond inherently teaches adjusting the display window to full-screen size (See column 15, lines 57-61; col. 17, lines 25-31).

Regarding claim 10, Zigmond discloses the ad even signal that is embedded in the streaming video program (column 8, lines 39-41; col. 15, lines 47-52).

Regarding claim 11, Zigmond discloses the ad event signal that is generated by a software program operating at the receiver (the system includes computer-readable media having computer executable instructions and software is included in the ad insertion device - see column 6 lines 48-50 line 26-36; col. 15, lines 40-44).

Regarding claim 17, Zigmond discloses a method for displaying advertising comprising: presenting a streaming video program in a video presentation window (58) (see figures 7-8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37); pausing presentation of the streaming video program in response to the ad event signal (the advertisement insertion device interrupts

the display of the video programming in response to the trigger signal - column 15, lines 57-61; col. 17, lines 25-31); selecting a display window other than the video presentation window in response to the ad event signal (when the advertisement signal interrupts the display of the video programming feed, the video display inherently opens up a new window in which to display the advertisement - column 7, lines 26-32 and column 16, lines 30-43); saving the contents of the display window (the paused video program is saved since it is opened back up to its pre-advertisement position once the advertisement has been displayed in its entirety – see column 7, lines 26-32 and column 16, lines 35-45); disabling at least one control function of said video presentation window (since the advertisement is displayed on the display screen in full screen size, displaying the video program on the display screen is disabled); adjusting said video presentation window to a predetermined size in response to said ad event signal (the advertisement is displayed on a display screen in a full screen size in response to the trigger signal. See column 15, lines 57-61; col. 17, lines 25-31); displaying advertising in said video presentation window in response to said ad event signal (column 15, lines 57-61; col. 17, lines 25-31); restoring the contents of the display window (the paused video program is restored since once the advertisement has been displayed, the video presentation window opens back up at the position in which it was last at before the advertisement was displayed, column 7, lines 26-32 and column 16, lines 35-45); and resuming presentation of the streaming video program (column 16, lines 35-41).

Regarding claim 19, Zigmond teaches re-enabling said at least one control function of said presentation window (re-enabling the control function of displaying the video program on the display screen after the advertisement is complete).

Regarding claim 22, Zigmond teaches adjusting said video presentation window to a predetermined size (the advertisement is displayed on a display screen in a full screen size in response to the trigger signal. See column 15, lines 57-61; col. 17, lines 25-31).

Regarding claim 24, Zigmond teaches preventing resizing of said display window (since the video or content is displayed on the screen in full screen size, the system does not permit the user to resize the screen).

Regarding claim 25, Zigmond discloses a method for displaying advertising in conjunction with a streaming video program comprising: presenting a streaming video program in a video presentation window (displaying a video program on a screen 58) (see Fig. 7 and 58; Fig. 8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37), pausing presentation of the streaming video program in response to the ad event signal (the advertisement insertion device interrupts the display of the video programming in response to the trigger signal - column 15, lines 57-61; col. 17, lines 25-31); opening a display window and adjusting said display window to a predetermined size in response to said ad event signal (the advertisement is displayed on a display screen in a full screen size in response to the trigger signal. See column 15, lines 57-61; col. 17, lines 25-31); displaying advertising in said display window (the advertisement is displayed on screen - see column 15, lines 57-61; col. 17, lines 25-31); closing the display window (after the advertisement is complete) and resuming presentation of the streaming video program (see col. 17, lines 35-37).

Regarding claim 26, Zigmond teaches disabling at least one control function of said display window (since the advertisement is displayed on the display screen in full screen size, displaying the video program on the display screen is disabled).



Regarding claim 27, Zigmond inherently teaches adjusting the display window to full-screen size (See column 15, lines 57-61; col. 17, lines 25-31).

Regarding claim 28, Zigmond discloses the ad even signal that is embedded in the streaming video program (column 8, lines 39-41; col. 15, lines 47-52).

Regarding claim 29, Zigmond discloses the ad event signal that is generated by a software program operating at the receiver (the system includes computer-readable media having computer executable instructions and software is included in the ad insertion device - see column 6 lines 48-50 line 26-36; col. 15, lines 40-44).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siler (US 20040133467 A1) in view of Bates (US 6,342,908 B1) and further in view of Dwek (US 20010018858 A1).

Regarding claim 12, Siler discloses a method for displaying advertising in conjunction with a streaming video program comprising: presenting a streaming video program in a video presentation window (e.g., via media player window - 0027); receiving an ad event signal (trigger signal – see 0019, 0034); continuing presentation of the streaming video program (continuing playing the stream video program in window media player window - see 0027-0028); overlaying the streaming video program with an advertisement in response to the ad event signal (i.e., overlaying of advertisement in response to the trigger signal – see 0005, 0028,

0034); and continuing presentation of the streaming video program (continuing playing the stream video program in window media player window - see 0027-0028).

Siler fails to specifically teach checking the size of the video presentation window in response to a control signal, adjusting the size of the video presentation window to a predetermined size if said video presentation window is of another size and restoring the size of the video presentation window if the size was adjusted. However, Bates teaches checking the size of window 430 when the user request to open a new window, adjusting the size of window 430 to a smaller size, and restoring the window 430 back to the original size (see col. 7, lines 39-48 and 50-64; col. 8, lines 3-7; figures 4C-4F). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Siler by checking the size of the video presentation window in response to a control signal, adjusting the size of the video presentation window to a predetermined size if the window is of another size and restoring the size of the video presentation window if the size was adjusted as taught by Bates in order to effectively improve organizing windows on a display.

Siler does not explicitly teach disabling at least one control function of the video presentation window. However, Dwek teaches that the system does not permit a user to hide advertisement presentation window on the display screen (see 0113). It would have been obvious to one of ordinary skill in the art to modify the combined system of Siler and Bates by disabling at least one control function of advertisement presentation window such as hiding the advertisement presentation window on the display screen as taught by Dwek in order to increase the effectiveness of presenting advertisements to viewers.

Regarding claim 13, Siler teaches that the trigger signal is embedded in the streaming video program (see 0019).

Regarding claim 14, Siler discloses that the trigger signal is generated by a software program operating at the receiver (see 0015, 0019, 0020).

Regarding claim 16, Siler teaches re-enabling said at least one control function of said video presentation window (for example, the user may close the media player window after the streaming video program is complete – see 0027).

6. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (US 6,698,020) in view of Dwek (US 20010018858 A1).

Regarding claim 23, Zigmond discloses a method for displaying advertising comprising: presenting a first streaming video program in a video presentation window (58) (see figures 7-8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37); adjusting the size of said display window to a predetermined size in response to said ad event signal (the ad insertion device 80 interrupts display of the video programming content to insert in its place a selected advertisement based upon the presence of a triggering signal. It must be understood that the ad insertion device 80 arranges or makes suitable for displaying the advertisement on a display screen in full screen size response to the trigger signal. See column 15, lines 57-61; col. 17, lines 25-31); displaying a first advertisement associated with the first streaming video program in response to the ad event signal (see column 7, lines 26-32); receiving a second streaming video program (the program feed will include a first and any other subsequent streaming video programs – see column 7, lines 23-25); setting an indicator if an advertisement is being presented in conjunction with the second streaming video program (the advertisement inserting device inserts advertisements in the programming feed in response to a trigger signal – see col. 8, lines 51-54; col. 15, lines 35-37 and 52-65); displaying a second advertisement associated with the second streaming video program if the indicator is set (col. 8, lines 30-38; col. 15, lines

52-65; col. 13, lines 48-58); presenting the second streaming video program in the video presentation window (the system displays a first and any subsequent streaming video program column 7, lines 23-25).

Zigmond teaches displaying disabling the presentation of the streaming video program in response to the trigger signal but does not explicitly teach "disabling at least one control function of a display window". However, Dwek teaches disabling control function of a display window displaying advertisements such as hiding the advertisement presentation window on the screen (see 0112, 0113, 0104). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Zigmond by minimizing or hiding a display window displaying the advertisements on the screen as taught by Dwek in order to increase effectiveness of presenting advertisements to viewers.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ngoc Vu/  
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PRIMARY EXAMINER  
Art Unit 2623

January 19, 2008